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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,911	10/22/2003	Koichi Maari		6383
530 7590 01/25/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/690,911	Applicant(s) MAARI, KOICHI	
	Examiner Calvin L. Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4-17-06</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-37 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites transmitting content, content key and billing information "upon request from said portable terminal". It is not clear to one of ordinary skill whether Applicant intends for the request to be coming *from* the portable terminal or the portable terminal transmits content, content key and billing information *upon receiving a request* from another terminal (say).

Claims 2-9 are also rejected as each depends from claim 1.

Claim 2 recites "wherein said content key is a *common* key" (emphasis added). Claim 1, from which claim 2 depends, recites "a content key *specified* for each digital content" (emphasis added). To one of ordinary skill a key that is specified or unique for each digital content cannot also be common or shared

across multiple pieces of content. For purposes of examination the Examiner is interpreting "common key" as a "symmetric key".

Claim 8 recites "... said content use information is received that is transmitted from said another party of communication upon request from he same for transmitting said billing information". It is not clear to one of ordinary skill what is being received (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989))

Claim 33 recites an apparatus that encodes content use information "when said billing request is encoded by said billing information request information encoding means". However, it has been held that such a claim is indefinite and limitations that express how a structure may perform will not distinguish the claimed structure from the teachings of the prior art (*In re Collier*, 158 USPQ 266 (CCPA 1968)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No 5,892,900.

As per claims 1, 8-10, 12, 20-23, 25, and 33-37 Ginter et al. teach:

- encoding digital content using a content specific key (figures 17-20; column 223, lines 5-13) and compressing the encoded digital content (column 68, lines 43-59)
- transmitting from a terminal encoded content and an encoded content key to a requesting terminal (figures 2, 2A and figures 79-84; column 62, lines 31-50 and 52-64; column 137, lines 35-50)
- encoding and transmitting billing information that is decremented each time content is decoded (i.e. indicative of content use) (column 9, lines 59-63; column 31, lines 8-38; column 24, lines 25-54; column 45, lines 30-48)
- receiving content use information (e.g. rights) and distributing fees based on content use information to a content creator (figures 17-20; column 31, lines 5-7; column/line 36/44-37/14; column 155, lines 38-60; column 166, lines 20-31; column 278, lines 5-37; column/line 315/58-316/5)
- converting a digital signal to an analog signal (column /line 60/57-61/4; column 62, lines 32-50)
- encrypting communications between parties (column/line 207/14-208/32; column 222, lines 3-12)

Payment reminders are old and well known (see also claims 10 and 20, transmitting billing information upon request). Therefore, as Ginter et al. also teach collecting usage information in order to generate billing information (column 43, lines 52-56; column/line 329/58-330/8) and sending a request for administrative information from a payment center to an end user (column 169, lines 17-33), it would have been obvious to one of ordinary skill to send a reminder to a user that payment (based on monthly usage information- column 336, lines 38-46) is due. Regarding portable terminals, Ginter et al. direct their secure content distribution system to the broad class of electronic appliances that contain one or more microcomputers, microcontrollers or CPUs (figure 7; column/line 60/58-61/34; column 62, lines 47-50). More specifically, Ginter et al. apply their system to portable terminals that function as stand alone terminals (column 254, lines 56-62; column/line 255/5-256/38) such as a "card shaped" appliance or integrated circuit (column 60, lines 7-55; column/line 255/29-256/38)

As per claims 2-7, 14-19, and 27-32 it is old and well known to encrypt a message (i.e. content) using a symmetric, session or shared key and encrypt the symmetric key with a public key of a public/private key pair. Ginter et al. also teach interchanging the use of symmetric and asymmetric cryptography within their system (column/line 207/18-208/32).

As per claims 11 and 24, seeking accuracy in billing is old and well known.

As per claims 13 and 26, external memory such as memory sticks, flash drives and external hard drives are old and well known.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Okamoto teaches confirming accuracy in billing for charges accumulated over a time period
- Wahwani et al. disclose payment reminders
- Meschil teaches payment reminders
- "Flash memory" Microsoft Press Computer Dictionary 3rd Edition
- Applied Cryptography, pg 33, "hybrid cryptosystems", Bruce Schneier

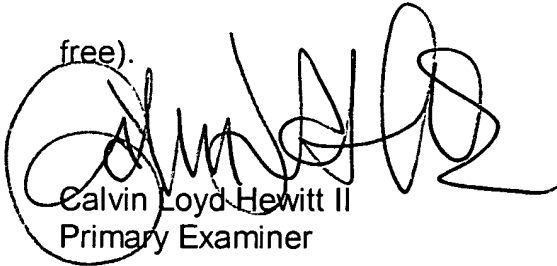
7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

January 21, 2007